

REMARKS/ARGUMENTS

In the Office Action mailed November 18, 2003, claims 1-24 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

CLAIM REJECTIONS – 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 4, 5, 23 and 24 under 35 U.S.C. §112, First Paragraph as failing to comply with the written description. Applicants have amended the claims to amend the claims from digital automotive tester to digital multimeter. Support for the is amendment is found is the specification at pages 13 and 14 and therefore no new matter is added. Applicants respectfully request that the amendment be entered and the rejection be removed.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

The Examiner rejected claims 1-3 and 9-18 under 35 U.S.C. § 103(a) as being obvious over Tambini in view of United States Patent No. 4,845,998 to DeMartelaere *et al.* (hereinafter referred to as "DeMartelaere"). Claims 6 and 20 are rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of DeMartelaere and in further view of United States Patent No. 5,095,746 to Stanis (hereinafter referred to as "Stanis"). Claims 7 and 21 were rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of DeMartelaere and further in view of Stanis and United States Patent No. 4,308,779 to Suzuki (hereinafter referred to as "Suzuki").

Claims 8 and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of DeMartelaere and in further view of United States Patent No. 5,571,971 to Chastel *et al.* (hereinafter referred to as “Chastel”). Claim 19 was rejected under 35 U.S. C. § 103(a) as being obvious over Tambini in view of DeMartelaere and in further view of United States Patent No. 6,345,436 to Codrington (hereinafter referred to as “Codrington”).

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *MPEP* §2142. To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142.

Applicants respectfully point to the first prong of the test, which states the prior art must teach all the claim limitations. Applicants note that the Examiner in each rejection under this section has consistently stated that “it would have been obvious to one of ordinary skill in the art at the time the invention to combine the teachings” of all the cited references. The Examiner does not point to any suggestion or motivation in the references themselves to support such a finding. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In fact, it appears from the rejections and cited references that the Examiner has used hindsight reconstruction to arrive at the claimed invention. “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)

Applicants note that at the least, the references do not teach the aspect of positioning of the shaft between the tool and the fastener and that the shaft is linked to an angle rate sensor such that the speed and direction of the torque applied is measured such that the desired angle of rotation is achieved. Therefore, as noted previously, the advantage of such a system is that it can be used with a mechanic's existing tools and does not require a special set of tools. Further, the device is capable of fitting into smaller more compact places. This could not be accomplished with the prior art. Further, the prior art does not disclose an angle rate sensor linked to the shaft such that it measures the speed and direction of the torque. None of the references individually or in combination teach the claimed invention. Therefore, Applicants respectfully request that the obviousness rejection as applied to these claims be removed and the claims be allowed to pass to issuance.

CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the objections and rejections made in the outstanding Office Action. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1703 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out by telephone.

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Serial No. 09/964,470
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Patent

In the event this paper is not time filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036, with reference to our docket number 87355.3000.

Respectfully submitted,

BAKER & HOSTETLER LLP



Dennis P. Cawley
Reg. No. 44,598

Date: 12/10/2003
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304
Telephone: 202-861-1500
Facsimile: 202-861-1783